C. Remarks

The claims are 28-33, with claims 28, 30, 32, and 33 being independent. The independent claims have been amended to better define the invention. Support for the amendment may be found throughout the specification, for example, in the First to Third Embodiments, as well as in Figs. 1-3. No new matter has been added. Reconsideration of the present claims is expressly requested.

Claim 28 is objected to due to a minor informality. Applicant has corrected the indicated informality and respectfully requests withdrawal of the objection.

Claims 32 and 33 stand rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Specifically, the Examiner alleged that a claim reciting only a reading step, an acquisition step, a comparison step, and a generating step does not pertain to a method that produces any physical transformation or a tangible result.

Claims 32 and 33 have been amended to clarify that test information is generated and outputted to a storage medium. Thus, Applicant respectfully submits that claims 32 and 33 satisfy the requirements of 35 U.S.C. § 101, as recently articulated by the Federal Circuit in the *In re Bilski* case. Thus, withdrawal of the above rejection is respectfully requested.

Claim 31 stands rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Specifically, the Examiner alleged that the phrase "when the identification information acquired in the acquisition step is not stored in the storing means, determines that the particular subject is a new subject and stores the test

information in association with the acquired identification information" is indefinite, because it is not clear whether the identification information is being stored.

Applicant respectfully submits that it is clear from claim 31 that when the identification information is new (i.e., was not previously stored), this newly acquired identification information is stored with the test data. Accordingly, withdrawal of the indefiniteness rejection is respectfully requested.

Claims 28-33 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Publication No. 2004/0048259 A1 (Hashmi). Claims 30 and 31 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Application Publication No. 2002/0110823 A1 (Hogan). Claims 30 and 31 also stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Publication No. 2005/0064436 A1 (Barrett). Claims 28, 29, 32 and 33 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Hogan in view of U.S. Patent No. 5,876,926 (Beecham). Claims 28, 29, 32 and 33 also stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Barrett in view of Beecham. The grounds of rejection are respectfully traversed.

As recited in claims 28 and 30, a testing method according to the present invention using a DNA microarray comprises hybridizing the DNA microarray with DNA including genes suitable for personal identification and disease-related genes extracted from a specimen of a particular subject. The DNA microarray includes a first DNA probe group that reacts with the genes suitable for personal identification and is capable of being used to identify a subject and a second DNA probe group that reacts with the disease-

related genes. Also, the DNA microarray has two separated areas, one of which is an area where probes of the first DNA probe group are arranged and the other is an area where probes of the second DNA probe group are arranged. Due to carrying out the test using a microarray with such an arrangement, identification can be easily performed from a hybridization pattern. In addition, this makes it easy to change a probe design for disease-related genes.

Hashmi is directed to compositions and methods for genetic testing. This document teaches detecting an identification marker and a disease gene using a DNA array on which beads are settled, as shown in Fig. 1. However, Hashmi fails to disclose or suggest using a DNA array that has two separated areas, one with probes for an identification marker and the other with probes for disease-related genes.

Hogan is directed to methods for genomic screening of subjects. Specifically, Hogan teaches that a genomic profile including a set of markers for the course of treatment and a genomic profile including a set of unique genomic identifiers are determined by using a DNA array. However, Hogan fails to disclose or suggest using a single DNA array with separated probe areas as presently claimed.

Barrett is directed to methods and compositions for identifying patient samples. This document teaches dividing a sample into two parts. One part is screened for an SNP profile. The other part is screened for clinical analytes. However, Barrett, like the other above-discussed documents, fails to disclose or suggest providing a single DNA array with two types of probe groups separated as claimed.

Beecham cannot provide the teachings missing in Hashmi, Hogan, and Barrett. Beecham is directed to a method and an apparatus for obtaining biometric data from a test subject for identification and testing a sample obtained from the test subject. However, as acknowledged previously by the Examiner, Beecham fails to disclose or suggest performing these two processes using a single microarray.

As recited in claims 32 and 33, a testing method in accordance with the present invention may also include comparing an identification information acquired from the hybridization result of the first DNA probe group with an identification information stored in a storage device and analyzing the hybridization state of the second DNA probe group if the comparison indicates that both sets of identification information match. Thus, when identification is successful, there is a high probability that hybridization is successful, and the state of the disease of a subject can be determined quickly and accurately.

Applicant respectfully submits that neither Hashmi, Hogan, Barrett, nor Beecham discloses or suggests a testing method with such a procedure. Applicant further notes that claims 32 and 33 clearly indicate that the hybridization state of the second DNA probe group is analyzed only when the information is determined to match. As stated previously, this enhances privacy protection.

In conclusion, Applicant respectfully submits that the cited references, whether considered separately or in any combination, fail to disclose or suggest the presently claimed elements.

Wherefore, expedient allowance of the claims and passage to issue are respectfully requested.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

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